

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371		ATTORNEY'S DOCKET NUMBER 071949-9701 (prev. 039386-2269) <small>U.S. APPLICATION NO. (If known, see 37 C.F.R. 1.5)</small> 10/535,635
INTERNATIONAL APPLICATION NO. PCT/US03/38178	INTERNATIONAL FILING DATE 11/25/2003	PRIORITY DATE CLAIMED 11/26/2002
TITLE OF INVENTION IMMUNE RESPONSE-ASSOCIATED PROTEINS		
APPLICANT(S) FOR DO/EO/US Uyen K. TRAN et al.		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
<ol style="list-style-type: none"> 1. <input type="checkbox"/> This is a FIRST submission of items concerning a filing under 35 U.S.C. 371. 2. <input checked="" type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371. 3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below. 4. <input type="checkbox"/> The US has been elected (Article 31). 5. <input type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2)) <ul style="list-style-type: none"> <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau). <input type="checkbox"/> has been communicated by the International Bureau. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US) 6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)). <ul style="list-style-type: none"> <input type="checkbox"/> is attached hereto. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4). 7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) <ul style="list-style-type: none"> <input type="checkbox"/> are attached hereto (required only if not transmitted by the International Bureau). <input type="checkbox"/> have been communicated by the International Bureau. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired. <input type="checkbox"/> have not been made and will not be made. 8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)). 9. <input checked="" type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). NARINDER K. CHAWLA 10. <input type="checkbox"/> An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)). 		
Items 11 to 20 below concern other document(s) or information included:		
<ol style="list-style-type: none"> 11. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98. 12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included. 13. <input type="checkbox"/> A preliminary amendment. 14. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76. 15. <input type="checkbox"/> A substitute specification. 16. <input type="checkbox"/> A power of attorney and/or change of address letter. 17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 – 1.825 18. <input type="checkbox"/> A second copy of the published international application under 35 U.S.C. 154(d)(4). 19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4). 20. <input checked="" type="checkbox"/> Other items or information: Response to Petition Decision under 37 CFR §1.47(a) (1 page); Returned Copy of Petition Decision (4 pages). 		

FORM PTO-1390 (Modified)

RECEIVED

22 AUG 2006

 Legal Staff
Intellectual Division

U.S. APPLICATION NO. (If known, see 37 CFR. 1.5) 10/535,635		INTERNATIONAL APPLICATION NO. PCT/US03/38178		ATTORNEY'S DOCKET NUMBER 071949-9701	
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The following fees have been submitted:					
21. <input type="checkbox"/> Basic national fee	\$300			\$	0.00
22. <input type="checkbox"/> Examination fee					
If International preliminary examination report prepared by USPTO and all claims satisfy provisions of PCT Article 33(1)-(4)			\$100	\$	0.00
All other situations			\$200		
23. <input type="checkbox"/> Search fee					
Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority			\$100		
International Search Report prepared and provided to the Office			\$400		
All other situations			\$500	\$	0.00
TOTAL OF ABOVE 21, 22 and 23 =				\$	0.00
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$ for each additional 50 sheets of paper or fraction thereof.					
Total Sheets	Extra sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	RATE		
161 - 100 = 0	/50 =	0	x \$250.00	\$	0.00
Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months from the earliest claimed priority date (37 CFR 1.492(e))				\$	0.00
CLAIMS	Current Prev. Paid	NUMBER EXTRA	RATE	\$	
Total Claims	18 - 20 = 0		x \$ 50.00	\$	0.00
Independent Claims	1 - 3 = 0		x \$ 200.00	\$	0.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+ \$ 360.00	\$	
TOTAL OF ABOVE CALCULATIONS =				\$	0.00
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.				+	\$ 0.00
SUBTOTAL =				\$	0.00
Petition for One Month Extension of Time:				\$	0.00
TOTAL NATIONAL FEE =				\$	0.00
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). 40.00 per property				\$	
TOTAL FEES ENCLOSED =				\$	0.00
				Amount to be refunded:	
				charged:	

a. ☐ A check in the amount of 0.00 to cover the above fees is enclosed.

b. ☐ Please charge my Deposit Account No. 19-0741 in the amount of 0.00 to cover the above fees. A duplicate copy of this sheet is enclosed.

c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 19-0741.

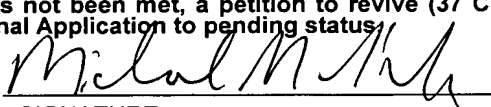
d. ☐ Fees in the amount of \$0.00 are to be charge to a credit card. **WARNING:** Information on this form may become public. **Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

SEND ALL CORRESPONDENCE TO:

Foley & Lardner LLP
Customer Number: 22428

August 2, 2006


 SIGNATURE
Michele M. Simkin
 NAME
34,717
 REGISTRATION NUMBER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Uyen K. Tran, et al.
Title: IMMUNE RESPONSE-ASSOCIATED PROTEINS
Appl. No.: 10/535,635
International Filing Date: May 20, 2005
Examiner: Unassigned
Art Unit: 1644
Confirmation Number: 7561

RESPONSE TO PETITION DECISION
UNDER 37 C.F.R. § 1.47(a) – Narinder K. Chawla

Sir:

In response to the attached Petition Decision dated June 8, 2006, Applicants enclose a declaration complying with 37 C.F.R. § 1.63 signed by inventor Narinder K. Chawla, who has joined in as a joint-inventor of the above identified application.

Although Applicant believes that no fee is required for this Response, the Commissioner is hereby authorized to charge any additional fees which may be required for this Response to Deposit Account No. 19-0741.

If there are any questions regarding the above, please contact the undersigned.

Respectfully submitted,

Date August 2, 2006

By Michele M. Simkin

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

Michele M. Simkin
Attorney for Applicants
Registration No. 34,717



08 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

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In re Application of
TRAN *et al*
U.S. Application No.: 10/535,635
PCT No.: PCT/US2003/038178
Int. Filing Date: 25 November 2003
Priority Date: 26 November 2002
Attorney Docket No.: 039386-2269
For: IMMUNE RESPONSE-ASSOCIATED
PROTEINS

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a) -
Nainder K. Chawla" filed 02 March 2006.

BACKGROUND

On 05 December 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 02 March 2006, applicants filed the instant petition which was accompanied by, *inter alia*, the petition fee; a one-month extension and fee; the surcharge fee; a declaration; copies of two letters; and copies of FedEx postal delivery results.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (3), the last known address of Narinder K. Chawla-Walis is listed as:

33 Union Square # 417
Union City, CA 94587

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by fourteen of the fifteen named inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the nonsigning inventor "is refusing to join in the subject application by executing the Declaration. Further, Ms. Chawla-Walia is now unable to be located." These allegations will be discussed, in turn.

Section 409.03(d) of the MPEP discusses a refusal by an inventor to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Petitioners claim that Christine Arthur, a legal assistant of counsel, talked to the nonsigning inventor on 07 September 2005 about the documents mailed 31 May 2005.

Ms. Chawla-Walia told Ms. Arthur that she needed another copy of the documents as the documents mailed 31 May 2005 were misplaced during a move. A duplicate set of documents were sent that day. But FedEx delivery records show that these documents were delivered to an address other than the recipient.

Ms. Arthur called the nonsigning inventor again on 14 November 2005 and was told that the documents were never received. Petitioners sent more documents to the new address on 16 November 2005 and delivery records indicate that they were delivered. Ms. Chawla-Walia did not respond to the deadline of 01 December 2005 and subsequent telephone calls by Ms. Arthur indicate that the phone has been disconnected.

A review of the letter dated 16 November 2005 shows that only a Declaration and Assignment were included. There is no indication that a copy of the subject application was included. While the cover letter dated 31 May 2005 did state that a copy of the international application was included, the facts as described in the petition suggest that the nonsigning inventor had misplaced these papers. Moreover, the statements in the petition are complete hearsay. An affidavit by the person with direct knowledge of the conversations (Ms. Arthur) is required. For these two reasons, a refusal to cooperate has not been shown.

Section 409.03(d) of the MPEP also discusses situations where an inventor cannot be reached and states, in part:

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioners have not made a showing that a diligent effort was made to locate the nonsigning inventor. There is no indication that any search was performed. No documentary evidence of searches was submitted. Moreover, a statement of facts by the person having firsthand knowledge of the facts (Ms. Arthur) is also required. For these reasons, petitioners have not made an acceptable showing of diligent effort to locate the nonsigning inventor.

For the reasons discussed above, item (2) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

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